

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on September 8, 2009.

PATENT
Attorney Docket No.: 020489-000410US

TOWNSEND and TOWNSEND and CREW LLP

By: /Tiffany Wu/

Tiffany Wu

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eric A. Goldfarb

Patent No.: 7,563,273

Issued: July 21, 2009

Application No.: 10/803,444

Filed: March 17, 2004

For: METHODS AND DEVICES FOR
CAPTURING AND FIXING LEAFLETS
IN VALVE REPAIR

Customer No.: 76081

Confirmation No.: 5450

Examiner: WOO, JULIAN W

Art Unit: 3773

REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37
C.F.R. §1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Before this patent issued, Applicants filed a request for patent term adjustment under 37 C.F.R. §1.705(b) on March 3, 2009. Applicants had requested that pursuant to the holding of *Wyeth v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), the determination of patent term adjustment be corrected from 527 days to 687 days (at minimum), on the basis that the Office would take in excess of three years to issue this patent. Applicants calculated the patent term adjustment on the basis of a RCE date of August 24, 2007.

A Petition Decision from the PTO mailed on June 15, 2009, indicated that this prior request would be **held in abeyance** until after the actual issuance of the patent. Applicants were given two months from the issue date of the patent (*i.e.*, until September 21, 2009) to file a

request for reconsideration of the patent term adjustment. The Petition Decision indicated that Applicants would not have to pay an additional fee upon seeking reconsideration.

Accordingly, Applicants now timely file a request for reconsideration of the patent term adjustment under 35 U.S.C. §154(b). It is respectfully requested that Applicants be granted a total patent term adjustment of 705 days. As required, Applicants submit a statement of facts as required under 37 C.F.R. §1.705(b)(2), below.

Applicants also enclose a copy of the prior Petition Decision as requested. Applicants believe **no fee is required** for this submission, since the fee was originally paid with the first Request filed on March 3, 2009. However, the Commissioner is authorized to charge any necessary additional fees or credit any overpayments to the Deposit Account No. 20-1430.

As mentioned, this request is prompted by the court decision in *Wyeth v. Dudas* (Case No. 07-1492, D.D.C. 2008) which held that the periods of delay under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(b) overlap only if they occur on the same calendar day or days.

Statement of Facts

Correct Patent Term Adjustment and Bases Under §§ 1.702, 1.703, and 1.704 for the Adjustment

The correct patent term adjustment is 705 days, not 545 days as stated on the face of the patent issued on July 21, 2009.

The period of adjustment under 37 C.F.R. § 1.702(a) is 572 days (“A delay”).

The period of adjustment under 37 C.F.R. § 1.702(b) is 160 days (“B delay”).

The period of overlapping days over the period of adjustments under 37 C.F.R. §§ 1.703(a)-(e) is 0 days.

The period adjustment under 37 C.F.R. § 1.704(a) is 27 days (“applicant delay”).

The period of adjustment under 37 C.F.R. §1.703(f) is 705 days ((“A delay” + “B delay” – “Overlapping Days”) – “applicant delay”).

The relevant dates as specified in 37 C.F.R. §§ 1.703(a)-(e) &
the adjustment specified in 37 C.F.R. § 1.703(f)

1. § 1.703(a)

Applicants are in agreement with the USPTO determination of a period of adjustment of 572 days under 37 C.F.R. § 1.703(a). (*See* Exhibit A, attached hereto).

2. § 1.703(b)

The period of adjustment under 37 C.F.R. § 1.702(b) begins on the day after the date that is three years from the filing date of the instant application, March 17, 2007, and ends on the day the patent is issued.

The period of adjustment does not include the period beginning on the date on which an RCE was filed, August 24, 2007. *See* 37 C.F.R. § 1.703(b)(1).

Thus, the effective period of adjustment under 37 C.F.R. § 1.702(b) is 160 days, *i.e.*, from March 17, 2007 to August 24, 2007.

3. § 1.703(c)-(e)

There are no relevant dates as specified under §§ 1.703(c)-(e).

4. Calculation of Overlapping Days under § 1.703(f)

There are no overlapping periods under §§ 1.703(a)-(e).

Applicants request that overlapping periods be determined in accordance with *Wyeth v. Dudas* (Case No. 07-1492, D.D.C. 2008). The periods of delay under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) overlap only if they occur on the same calendar day or days.

Reduction of period of adjustment of patent term under 37 C.F.R. §1.704

Application are in agreement with the U.S. Patent and Trademark Office determination of an adjustment of 27 days under 37 C.F.R. § 1.704(a).

Terminal Disclaimer

Assignees of the patent note that no terminal disclaimer has been filed in the above-referenced patent at this point.

Patent Term Adjustment Determination

Applicants are entitled to 687 days of patent term adjustment, *i.e.*,
[(A delay (572 days) + B delay (160 days) – overlap (0 days)) minus [27 days (applicant delay)]
under 37 C.F.R. § 1.703(f).

Based on the foregoing, Applicants respectfully request reconsideration of the
patent term adjustment determination.

Respectfully submitted,

/Douglas Portnow/

Douglas Portnow
Reg. No. 59,660

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
D3P:tfw

Attachments

62184224 v1



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

COPY MAILED

JUN 15 2009

OFFICE OF PETITIONS

TOWNSEND AND TOWNSEND AND
CREW
LLP/EVALVE INC. (020489)
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111

In re Application :
Goldfarb, et al. :
Application No. 10/803,444 : PATENT TERM ADJUSTMENT
Filed: March 17, 2004 :
Dkt. No.: 020489-000410US :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION," filed March 3, 2009. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR 1.705(b). The application for patent term adjustment was timely filed January 28, 2009, along with issue fee payment.

Applicants do not dispute the adjustment of to date of 527 days (adjustment totalling 554 days for Office delays less reductions totalling 27 days for applicant delays). Instead, applicants contest the adjustment insofar as it relates to the Office's failure to issue the patent within three years of the filing date of the application pursuant to 37 CFR 1.703(b) in view of Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008). In this regard, applicants request an increase of adjustment from 527 days to 687 days.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, 37 CFR 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

A handwritten signature in cursive script, reading "Alesia M. Brown".

Alesia M. Brown
Petitions Attorney
Office of Petitions

10/803,444	METHODS AND DEVICES FOR CAPTURING AND FIXING LEAFLETS IN VALVE REPAIR	08-31-2009:13:49:28
------------	---	---------------------

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/803,444

Filing or 371(c) Date:	03-17-2004	USPTO Delay (PTO) Delay (days):	572
Issue Date of Patent:	07-21-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	27
Post-Issue Petitions (days):	+0	Total PTA (days):	545
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
07-01-2009	PTA 36 Months		
07-21-2009	Patent Issue Date Used in PTA Calculation	18	
06-19-2009	Dispatch to FDC	⌘	
06-15-2009	Mail-Petition Decision - Dismissed	⌘	
06-15-2009	Petition Decision - Dismissed	⌘	
03-23-2009	TC Return to Pubs	⌘	
03-04-2009	Pubs Case Remand to TC	⌘	
03-03-2009	Response to Reasons for Allowance	⌘	
03-03-2009	Petition Entered	⌘	
03-05-2009	Application Is Considered Ready for Issue	⌘	
03-03-2009	Issue Fee Payment Verified	⌘	
03-03-2009	Issue Fee Payment Received		
02-10-2009	Mail Notice of Allowance		
02-10-2009	Document Verification		
02-10-2009	Notice of Allowance Data Verification Completed		
02-10-2009	Case Docketed to Examiner in GAU		
02-10-2009	Examiner's Amendment Communication		
02-05-2009	Examiner Interview Summary Record (PTOL - 413)		
12-01-2008	Date Forwarded to Examiner		
11-03-2008	Response after Non-Final Action		
09-15-2008	Mail Non-Final Rejection		
09-12-2008	Non-Final Rejection		
06-19-2008	Information Disclosure Statement considered		
06-19-2008	Information Disclosure Statement (IDS) Filed		
06-26-2008	Date Forwarded to Examiner		
06-26-2008	Date Forwarded to Examiner		
06-10-2008	Request for Continued Examination (RCE)		
06-26-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
06-19-2008	Information Disclosure Statement (IDS) Filed		
06-10-2008	Workflow - Request for RCE - Begin		

05-22-2008	Mail Final Rejection (PTOL - 326)	
05-21-2008	Final Rejection	
02-04-2008	Miscellaneous Incoming Letter	
03-13-2008	Date Forwarded to Examiner	
02-04-2008	Response after Non-Final Action	
01-30-2008	Mail Examiner Interview Summary (PTOL - 413)	
03-08-2007	Examiner Interview Summary Record (PTOL - 413)	
12-12-2007	Correspondence Address Change	
11-21-2007	Mail Non-Final Rejection	
11-20-2007	Non-Final Rejection	
11-20-2007	Case Docketed to Examiner in GAU	
09-06-2007	Date Forwarded to Examiner	
08-24-2007	Request for Continued Examination (RCE)	16
09-06-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	✦
08-24-2007	Request for Extension of Time - Granted	✦
08-24-2007	Workflow - Request for RCE - Begin	✦
08-14-2007	Mail Advisory Action (PTOL - 303)	✦
08-09-2007	Advisory Action (PTOL-303)	✦
07-30-2007	Date Forwarded to Examiner	✦
07-27-2007	Amendment after Final Rejection	✦
05-08-2007	Mail Final Rejection (PTOL - 326)	✦
05-08-2007	Final Rejection	
12-29-2006	Information Disclosure Statement considered	
03-10-2007	Date Forwarded to Examiner	
03-05-2007	Response after Non-Final Action	11
03-05-2007	Request for Extension of Time - Granted	✦
12-29-2006	Electronic Information Disclosure Statement	✦
12-29-2006	Information Disclosure Statement (IDS) Filed	✦
11-22-2006	Mail Non-Final Rejection	554
11-20-2006	Non-Final Rejection	✦
05-03-2004	Information Disclosure Statement considered	✦
02-02-2006	Information Disclosure Statement considered	✦
02-02-2006	Reference capture on IDS	✦
02-02-2006	Information Disclosure Statement (IDS) Filed	✦
02-02-2006	Information Disclosure Statement (IDS) Filed	✦
10-26-2004	IFW TSS Processing by Tech Center Complete	✦
05-03-2004	Reference capture on IDS	✦
05-03-2004	Information Disclosure Statement (IDS) Filed	✦
05-03-2004	Information Disclosure Statement (IDS) Filed	✦
10-26-2004	Case Docketed to Examiner in GAU	✦
06-02-2004	Application Return from OIPE	✦

06-02-2004	Application Return TO OIPE	⌘
06-02-2004	Application Dispatched from OIPE	⌘
06-02-2004	Application Is Now Complete	⌘
04-16-2004	Cleared by OIPE CSR	⌘
04-14-2004	IFW Scan & PACR Auto Security Review	⌘
03-17-2004	Initial Exam Team nn	⌘

Close Window